

## **REMARKS**

This paper is responsive to an Office Action mailed March 21, 2008. Prior to this response, claims 1-21 were pending. After amending claims 1 and 11, and canceling claims 3 and 13, claims 1-2, 4-12, and 14-21 remain pending.

Claims 1-2 and 11-12 has been rejected under 35 U.S.C. 102(b) as anticipated by Shimizu (US 2002/0054313). The Office Action states that Shimizu discloses all the claim limitations in [0051-0056]. This rejection is traversed as follows.

Beginning at [0051] Shimizu discloses a process occurring in a host computer 102, where an application program 201 issues print information in a GDI format, which is converted by the OS to print information in a DDI format for use by a device driver. The print information analyzer 202 outputs image information [0052], which is eventually transferred to printing apparatus 101 [0053]. Shimizu's process is essentially the same process presented as prior art on page 2, ln. 13, through page 3, ln. 8 (Fig. 1a) in the Applicant's specification.

In contrast, claims 1 and 11 recite a document processing application that converts GDI data into an IR format that is proprietary to the document processing application. To further distinguish the claimed invention from Shimizu, claims 1 and 11 have been amended to include the subject matter of claims 3 and 13, respectively. Claims 1 and 11, as amended, recite that following the conversion to IR data, the IR data is supplied to a user interface (UI) display, where the IR data is manipulated in response to the user commands.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a

single prior art reference.” *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The recitation of “converting the GDI data into IR data proprietary to a document processing application” is a very explicit, narrow limitation. Shimizu does not disclose the conversion of GDI data into IR data. Shimizu does not disclose IR data proprietary to a document processing application. In fact, the terms “internal representation” and “IR” are not even used in the Shimizu disclosure. Further, Shimizu does not supply the IR data to a UI for manipulation. Therefore, Shimizu does not explicitly disclose every limitation of the claimed invention. Since Shimizu does not disclose every limitation of claims 1 and 11, he cannot anticipate those claims. Claim 2, dependent from claim 1, and claims 12, dependent from claim 11, enjoy the same distinctions from the cited prior art, and the Applicant respectfully requests that the rejection be removed.

The Office Action has rejected claims 3-7, 10, 13-17, and 20-21 under 35 U.S.C. 103(a) as unpatentable with respect to Shimizu in view of Mori et al. (“Mori”; US 2002/0054313). With respect to claims 3 and 13, the Office Action acknowledges that Shimizu fails to disclose supplying IR data to a UI for manipulation in response to editing commands. However, the Office Action states that Mori discloses such a feature, and that it would have been obvious to modify the system of Shimizu to include the print control method of Mori to provide a means of editing document data. This rejection is traversed as follows.

Beginning at [0178] Mori describes a print processor in a host computer, including the elements of an application 201, a graphic engine 202, a printer driver 203, and a system spooler 204. Fig. 3 is a more detailed

depiction of a host computer 3000, which includes all the elements of Fig. 2, plus additional elements such as a previewer 306 and a setting change editor 307. The previewer and setting change editor can be used preview a display, change print settings, and merge print jobs [0190]. Mori does not disclose the conversion of GDI data to IR data, or the presentation of IR data to a UI for manipulation in response to editing commands.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, the *KSR International Co. v Teleflex Inc.* decision (82 USPQ2d 1385, 1395-1397, 2007) suggests 7 exemplary rationales to support a conclusion of obviousness, which include:

- A) Combining prior art elements according to known methods to yield predictable results;
- B) Simple substitution of one known element for another to obtain predictable results;
- C) Use of known technique to improve similar devices (methods, or products) in the same way;
- D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

G) Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

The Office Action states that modifications to Shimizu would have been obvious to one of ordinary skill in the art in light of Mori. This rejection appears to be most closely grounded in the G) rationale - Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

With respect to this rationale, MPEP 2143 (G) states that the rejection must articulate the following criteria to resolve the *Graham* factual analysis:

(1) a finding that there was some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings;

(2) a finding that there was a reasonable expectation of success; and

(3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

With respect to the above-referenced first factual analysis criteria, the Mori reference has been combined with Shimizu based upon the assumption that Shimizu discloses every limitation recited in Applicant's claims 1 and 11. However, as noted in response to the anticipation rejection, Shimizu does not convert GDI data to IR data, or present IR data to a UI for

manipulation in response to editing commands. Mori does not disclose these limitations either. Therefore, even if Mori's previewer and setting change editor are combined with Shimizu, that combination does not explicitly disclose every limitation of claims 1 and 11. Claims 4-7, dependent from claim 1, and claims 14-17 and 20-21, enjoy the same advantages.

The Office Action states that it would have been obvious to apply the features of Mori to Shimizu's system for the purpose of editing document data. However, the general desire to edit documents does not explicitly suggest that GDI data be converted to IR data, and the IR data be presented to a UI for the purpose of editing. Neither reference mentions the use of IR data proprietary to a document processing application. Neither reference mentions the desirability or advantages of converting GDI data to IR data for the purpose of editing. The Office Action does not present a *prima facie* case that Mori suggests modifications to Shimizu that make the limitations of claims 1 and 11 obvious.

Alternately, a *prima facie* case for obviousness can be based upon evidence that modifications to Shimizu would have been obvious to one with skill in the art based upon what was well known at the time of the invention. "(A)nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). However, if the *prima facie* rejection is supported by what was known by a person of ordinary skill in the art, then additional evidence should have been provided. Notable, when the source or motivation is not

from the prior art references, “the evidence” of motive will likely consist of an explanation or a well-known principle or problem-solving strategy to be applied”. *DyStar*, 464 F.3d at 1366, 80 USPQ2d at 1649.

The only principle or problem-solving strategy mentioned in the Office Action is “editing”. The Office Action does not supply evidence that it was well known at the time of the invention to convert GDI data into document application proprietary IR data for the purpose of human-directed editing via a UI.

*A prima facie* analysis of motivation is especially critical in the present circumstances since the rejection is predicated on limitations that are not explicitly disclosed in the prior art references. The claimed invention can only be obvious if an artisan makes substantial modifications to Shimizu. However, there is nothing in the Mori reference that suggests an IR data conversion modification. Further, no evidence has been provided that such a modification would have been obvious based upon well known principles.

With respect to the second analysis criteria needed to support the G) obviousness rationale, even if a practitioner were given the Mori and Shimizu references as a foundation, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention. That is, there can be no reasonable expectation of success if the references, and what was known by artisan at the time of the invention, do not teach or suggest all the limitations of the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of Mori and Shimizu does not explicitly disclose every limitation of claims 1 and 11.

Neither has a case been supported that Shimizu can be modified to supply the missing limitations in view of Mori, or what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 4-7, 10, 14-17, and 20-21 be removed.

The Office Action has rejected claims 8-9 and 18-19 under 35 U.S.C. 103(a) as unpatentable with respect to Shimizu, Mori, and well known art. The Office Action acknowledges that Shimizu fails to disclose journaled scan data, but takes Official Notice that the ability to scan journaled data is well known in the art. The Office Action states that it would have been obvious convert scanned journaled documents into DDI data for increased user flexibility. This rejection is traversed as follows.

The Official Notice has been combined with Shimizu/Mori predicated upon the assumption that the combination of Shimizu and Mori discloses all the limitations of independent claims 1 and 11. However, as noted above, the combination of Shimizu and Mori fails to teach or suggest that GDI data be converted to IR data, and that the IR data be presented to a UI for the purpose of editing. Therefore, even if the element of journaled scan data is combined with Shimizu/Mori, the combination still fails to disclose the above-mentioned limitations. Claims 8-9, dependent from claim 1, and claims 18-19, dependent from claim 11, enjoy the same advantages.

The Office Action states it would have been obvious to scan journaled documents, and convert them to DDI data, to provide a user with greater flexibility and options. However, this statement does not explain how a practitioner in the art could have modified the Shimizu/Mori references to yield all the claimed invention limitations. As explained above, even when combined with journaled scan documents, Shimizu/Mori fail to disclose all of

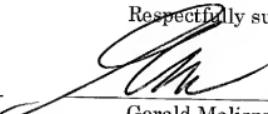
the claimed invention limitations. The above-quoted statement from Office Action does not explain how even a person with skill in the art could have modified Shimizu's previewer and setting change editor, to enable all the claimed limitations. Alternately stated, the motivation to supply all the limitations missing in the references cannot be inspired by a general desire to improve flexibility for the user, or even the recognition that journaled scan data can be converted to DDI data. Rather, there must be an explicit teaching in the conversion of journaled scan documents that shows a practitioner how Shimizu/Mori can be modified to yield the conversion of GDI data to IR data, or the use of IR data for UI-responsive editing. Such a *prima facie* case has not been made.

Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Shimizu that would make all the limitations obvious, the Applicant requests that the rejection of claims 8-9 and 18-19 be withdrawn.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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